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Paper No. 10

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JME 8/25/02 JPA

In re Application of
Jenkins, et al.
Application No. 09/777,979
Receipt Date February 6, 2001
Attorney Docket No. 70496

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JUN 25 2002

OFFICE OF PETITIONS

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.182, filed February 26, 2002, in response to the "Notice of Incomplete Nonprovisional Application (the "Notice").

The application was filed February 6, 2001. The Notice, mailed December 10, 2001, indicated that the application had not been accorded a filing date and that drawings were required along with a newly executed oath or declaration covering the drawings.

Petitioner argues that the application should be accorded a filing date of February 6, 2001, because, although the drawings were omitted, the subject application claims the benefit of provisional applications 60/249,096, 670/249,654, and 60/181,320 all of which contained the same full set of drawings that were omitted from the subject application. Applicant further argues that because the drawings were in the possession of the Office at the time the subject application was filed, the drawings would not constitute new matter and a new declaration would not be required.

Petitioner's arguments have been considered and found unconvincing. The declaration does indicate that the subject application claims the benefit of the aforementioned provisional applications, however; there was no incorporation by reference of the drawings from the named provisional applications into the disclosure of the present application on February 6, 2001.

Petitioner's attention is directed to the Manual of Patent Examining Procedure (MPEP), section 201.06 wherein it states, in pertinent part, that as a safeguard against inadvertent omissions of prior application papers, an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporate by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can be relied upon to permit the entering of a portion of the prior application into the continuing or divisional application when the portion or the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior applications will permit an applicant to amend the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference. However, a priority claim under 35 U.S.C. 120 in a continuation or divisional application does not amount to an incorporation by reference of the application to which priority is claimed. For the incorporation by reference to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or transmittal letter-as-filed or in an amendment specifically referred-to in an oath or declaration executing the application. Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. See, In re de Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973) and Dart Industries, Inc. v. Banner, 207 USPQ 273, 276 (D.C. Cir. 1980.)

There is nothing in the language cited in the application transmittal letter-as-filed or any of the application papers incorporating the provisional applications into the instant application. The mere reference to another application is not an incorporation of anything therein into the application containing the reference. The petition is accordingly dismissed.

As no proper incorporation by reference was filed, the drawings filed with the instant petition represent new matter and a newly executed declaration is required. The application will be accorded a filing date of the date the newly executed declaration is received.

Any request for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.182." This is not a final agency decision.

Further correspondence with respect to this matter should be addressed as follows:

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